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JUL 09 2007

OFFICE OF PETITIONS

In re Application of :
Timothy Skergan : DECISION ON PETITION
Application No. 08/353,008 :
Filed: December 9, 1994 :
Attorney Docket No. AT993110 :

This is a decision on the "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR §1.137(b)," filed April 2, 2007.

By Notice of Abandonment mailed November 30, 2001, applicant was advised that the application was abandoned as a result of failure to take appropriate action in a timely manner after the decision rendered on June 19, 2001 (not May 19, 2001 as stated in the notice) by the Board of Patent Appeals and Interferences. Therefore, the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(c). The notice stated as no claim was considered allowed, the application became abandoned.

Petitioner states they did not respond to the notice because claims did stand allowed. Thus, the application was not abandoned and should have passed to issue on the allowed claims 6-9.

It is noted that 37 CFR § 1.197(b) provides that:

- (1) Proceedings on an application are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§ 1.304) except:
 - (i) Where claims stand allowed in an application; or
 - (ii) Where the nature of the decision requires further action by the examiner.

A review of the decision of the board confirms that the decision of the examiner rejecting claims 6 through 9 were reversed. On August 17, 2001, applicants filed an amendment directed to claims other than 6 through 9. On September 10, 2001, the examiner responded to that amendment. However, with respect to claims 6 through 9, no further action has been taken. Given the decision by the Board as to claims 6 through 9, further action by the examiner was required. See MPEP § 1214.06.

However, it is noted that the instant application was filed on December 9, 1994, and the instant petition was filed on April 2, 2007, more than 5 years after the mailing of the notice of abandonment on November 30, 2001. As stated in MPEP 711.03(c),

37 CFR 1.137(d) requires, in pertinent part, that a petition under either 37 CFR 1.137(a) or 1.137(b) be accompanied by a terminal disclaimer (and fee), regardless of the period of abandonment, in:

...

(B) a nonprovisional utility application (other than a reissue application) filed before June 8, 1995

Alternatively, 37 CFR 1.181(f) also provides that, inter alia, except as otherwise provided, any petition not filed within 2 months from the action complained of may be dismissed as untimely. Therefore, any petition (under 37 CFR 1.181) to withdraw the holding of abandonment not filed within 2 months of the mail date of a notice of abandonment (the action complained of) may be dismissed as untimely. 37 CFR 1.181(f).

Rather than dismiss an untimely petition to withdraw the holding of abandonment under 37 CFR 1.181(f), the Office may require a terminal disclaimer as a condition of

granting an untimely petition to withdraw the holding of abandonment.

Under the circumstances of this application, the Office is requiring a terminal disclaimer. The period to be disclaimed is the terminal part of the term of any patent granted on the application, or of any patent granted on any utility or plant application that claims the benefit of the filing date of the application under 35 U.S.C. 120, 121, or 365(c), equivalent to the period between:

(A) the date that is two months after the mail date of the notice of abandonment; and

(B) the filing date of a grantable petition to withdraw the holding of abandonment.

Form PTO/SB/62 is the appropriate terminal disclaimer to be used, available at www.uspto.gov.

Petitioner filed a terminal disclaimer with this petition. However, a review of the terminal disclaimer reveals that it is improper. It does not disclaim the proper period, as set forth above. It states that applicant is disclaiming the lesser period of the period of abandonment of the application and thus, the period to be disclaimed should be zero (0) days. A proper terminal disclaimer (and fee) is required.

In view thereof, the petition is DISMISSED.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(b)."

Receipt of a change of correspondence address filed April 2, 2007 is acknowledged. However, the change of correspondence address will not be entered as the filing attorney, James Boice, is not an attorney of record in this application. A courtesy copy of this decision is being mailed to the address on the petition. All future correspondence will be mailed to the current correspondence address of record until such time as a proper change of correspondence address is filed.

Further correspondence with respect to this decision should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By fax: (571) 273-8300
ATTN: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

It is noted that the petition includes authorization to charge the Issue Fee and Publication Fee. Aside from the fact that the application remains abandoned, no Notice of Allowance or Notice of Allowability has been issued in this application. Applicants must file a response to any Notice of Allowance or Notice of Allowability within the statutory period for reply. Otherwise, the application will be abandoned. Applicant cannot rely on the response filed on petition as a response to any future Notice of Allowance or Notice of Allowability.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



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